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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/803,259

03/18/2004

Ralph B. Lilly

Anon-001:C

5397

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EXAMINER

NAJARIAN, LENA

ART UNIT

PAPER NUMBER

3626

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/803,259	<b>Applicant(s)</b> LILLY ET AL.	
	<b>Examiner</b> LENA NAJARIAN	<b>Art Unit</b> 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-10 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-10 and 22-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the Request for Continuation (RCE) filed 7/21/08. Claim 22 has been amended. Claims 1-4, 6-10, and 22-24 remain pending.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/20/08 has been entered.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4 and 6 rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham (US 6,859,780 B1) in view of Borsand et al. (US 2003/0074225 A1).

(A) Referring to claim 1, Cunningham discloses a method for tracking prescriptive medication, to address and control prescription drug abuse, said method comprising (abstract of Cunningham):

providing respective computer connections to a plurality of entities, said plurality of entities comprising a plurality of affiliated pharmacies (Fig. 1 and col. 4, lines 37-62 of Cunningham);

storing pharmaceutical computer data related to prescriptive medication purchases obtained by a plurality of prescriptive medication purchasers from said plurality of affiliated pharmacies (col. 2, line 64 – col. 3, line 10 and col. 3, lines 54-67 of Cunningham; the Examiner interprets “patients” to be a form of “prescriptive medication purchasers”); and

selectively transferring said pharmaceutical computer data through said computer connections to at least one of said plurality of entities for obtaining a prescriptive history of a selected prescriptive medication purchaser for medications purchased by said selected prescriptive medication purchaser from all of said plurality of affiliated pharmacies based on said transferred pharmaceutical computer data (col. 3, lines 4-10 and col. 3, lines 54-67 of Cunningham); and

generating from said prescriptive history of said selected purchaser one or more patterns which can be used by one or more viewers of said prescriptive history to flag the possibility of prescriptive drug abuse (col. 3, lines 54-67 of Cunningham).

Cunningham does not expressly disclose unaffiliated pharmacies and that the prescriptive history contains all prescriptive medications purchased in the aggregate.

Borsand discloses medication history that includes medication prescribed by other providers (para. 10, para. 11, and para. 56 of Borsand).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the aforementioned feature of Borsand within Cunningham. The motivation for doing so would have been to maximize the probability that pharmaceutical interactions and allergic reactions would be detected before a prescription is issued (para. 56 of Borsand).

(B) Referring to claim 2, Cunningham discloses providing that said at least one of said plurality of entities comprises a physician's office and said selected prescriptive medication purchaser is a patient of said physician (col. 2, lines 40-44 and col. 6, lines 44-61 of Cunningham); and

said prescriber utilizing said pharmaceutical computer data (Fig. 1 of Cunningham).

Cunningham does not expressly disclose that the physician's office verifies said prescriptive history of said selected prescriptive medication purchaser.

Borsand discloses the physician verifying said prescriptive history of said selected prescriptive medication purchaser (para. 56 of Borsand).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned feature of Borsand within Cunningham. The motivation for doing so would have been to maximize the probability that pharmaceutical interactions and allergic reactions would be detected before a prescription is issued (para. 56 of Borsand).

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(C) Referring to claim 3, Cunningham discloses providing that said at least one of said plurality of entities comprises a pharmacy with a pharmacist (col. 11, lines 38-40 of Cunningham);

said selected prescriptive medication purchaser requesting that said pharmacist fill a new prescriptive medication (col. 3, lines 54-57 of Cunningham); and

said pharmacist utilizing said pharmaceutical computer data to compare said new prescriptive medication with respect to said prescriptive history of said selected prescriptive medication purchaser (col. 3, lines 54-67 of Cunningham).

(D) Referring to claim 4, Cunningham discloses said pharmacist accepting or declining to fill said new prescriptive medication based on said prescriptive history (col. 3, lines 54-67 of Cunningham).

(E) Referring to claim 6, Cunningham does not expressly disclose providing that at least one of said plurality of entities comprises a hospital and said selected prescriptive medication purchaser is a patient of said hospital; and said hospital utilizing said pharmaceutical computer data to determine said prescriptive history of said selected prescriptive medication purchaser.

Borsand discloses providing that at least one of said plurality of entities comprises a hospital and said selected prescriptive medication purchaser is a patient of said hospital (para. 31 of Borsand); and said hospital utilizing said pharmaceutical computer data to determine said prescriptive history of said selected prescriptive medication purchaser (para. 56 of Borsand).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include a hospital within the system of Cunningham. The motivation for doing so would have been to include a variety of different settings that are used in treating patients (para. 31 of Borsand).

5. Claims 7-10 rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham (US 6,859,780 B1) in view of Borsand et al. (US 2003/0074225 A1), and further in view of Munoz et al. (US 2002/0052760 A1).

(A) Referring to claim 7, Cunningham discloses providing that said pharmaceutical computer data for each of said prescriptive medication purchases comprises a name of a respective prescriptive medication purchaser, a drug prescribed, said respective prescriptive medication purchaser, a quantity of said drug, a dosage of said drug, a pharmacist name, and a doctor name (col. 5, lines 16-60 and col. 6, lines 6-25 of Cunningham).

Cunningham and Borsand do not disclose an address of said respective prescriptive medication purchaser.

Munoz discloses an address of a respective prescriptive medication purchaser (para. 49 of Munoz).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned feature of Munoz within Cunningham and

Borsand. The motivation for doing so would have been to indicate where to send the delivery (para. 49 of Munoz).

(B) Referring to claim 8, Cunningham and Borsand do not disclose searching said stored pharmaceutical computer data based on one or more of said name of a respective prescriptive medication purchaser, said address of said respective prescriptive medication purchaser, said drug prescribed, said respective prescriptive medication purchaser, said quantity of said drug, said dosage of said drug, said pharmacist name, and said doctor name.

Munoz discloses searching said stored pharmaceutical computer data based on said drug prescribed (para. 41 of Munoz).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned feature of Munoz within Cunningham and Borsand. The motivation for doing so would have been to find records that meet the desired characteristics (para. 41 of Munoz).

Insofar as the claim recites "one or more of," it is immaterial whether or not the other elements are also disclosed.

(C) Referring to claim 9, Cunningham discloses storing pharmaceutical data related to whether a request for filling a prescriptive medication is filled or declined (col. 3, lines 54-67 of Cunningham).

(D) Referring to claim 10, Cunningham discloses providing that at least one of said plurality of entities comprises a government agency (col. 2, lines 54-59 of Cunningham).



6. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham (US 6,859,780 B1), in view of Rice et al. (US 2002/0042723 A1).

(A) Referring to claim 22, Cunningham discloses a method for tracking prescriptive medications, to address and control prescription drug abuse, said method comprising (abstract of Cunningham);

providing respective computer connections to a plurality of entities (Fig. 1, col. 4, lines 37-62, and abstract of Cunningham);

storing pharmaceutical computer data relating to prescriptive medication purchases obtained by a plurality of prescriptive medication purchasers from a plurality of pharmacies (col. 2, line 64 – col. 3, line 10 and col. 3, lines 54-67 of Cunningham; the Examiner interprets “patients” to be a form of “prescriptive medication purchasers”);

selectively transferring said pharmaceutical computer data through said computer connections to at least one of said plurality of entities for obtaining a prescriptive history of a selected prescriptive medication purchaser for all prescriptive medications purchased in the aggregate by said selected prescriptive medication purchaser from all of said plurality of pharmacies based on said transferred pharmaceutical computer data (col. 3, lines 4-10 and col. 3, lines 54-67 of Cunningham); and

generating from said prescription history of said selected purchaser one or more patterns which can be used by one or more viewers of said prescriptive history to flag the possibility of prescriptive drug abuse (col. 3, lines 54-67 of Cunningham).

Cunningham does not expressly disclose said plurality of entities being a group consisting essentially of a plurality of hospitals, a plurality of doctors, and at least one government agency, or combinations thereof.

Rice discloses said plurality of entities being a group consisting essentially of a plurality of hospitals, a plurality of doctors, and at least one government agency, or combinations thereof (see Fig. 1 and abstract of Rice).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned features of Rice within Cunningham. The motivation for doing so would have been to facilitate the retrieval and delivery of information and alerts to a plurality of sources/consumers (para. 13 and para. 18 of Rice).

7. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham (US 6,859,780 B1), in view of Rice et al. (US 2002/0042723 A1), and further in view of Edelson et al. (5,737,539).

(A) Referring to claim 23, Cunningham and Rice do not disclose wherein the one or more patterns from the prescriptive history would indicate prescription duplication, or multi-source prescription abuse.

Edelson discloses wherein the one or more patterns from the prescriptive history would indicate prescription duplication, or multi-source prescription abuse (col. 27, lines 32-54 of Edelson).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned feature of Edelson within Cunningham and Rice. The motivation for doing so would have been to control abuse by refusing to process the prescription (col. 27, lines 32-54 of Edelson).

8. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham (US 6,859,780 B1) in view of Borsand et al. (US 2003/0074225 A1), and further in view of Edelson et al. (5,737,539).

(A) Referring to claim 24, Cunningham and Borsand do not disclose Cunningham does not disclose wherein the one or more patterns from the prescriptive history would indicate prescription duplication, or multi-source prescription abuse.

Edelson discloses wherein the one or more patterns from the prescriptive history would indicate prescription duplication, or multi-source prescription abuse (col. 27, lines 32-54 of Edelson).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the aforementioned feature of Edelson within Cunningham and Borsand. The motivation for doing so would have been to control abuse by refusing to process the prescription (col. 27, lines 32-54 of Edelson).

### ***Response to Arguments***

9. Applicant's arguments with respect to claim 22 have been considered but are moot in view of the new ground(s) of rejection.

10. Applicant's additional arguments filed 6/20/08 have been fully considered but they are not persuasive. Applicant's arguments were addressed in the Advisory Action mailed 09 July 2008, and are incorporated herein.

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LENA NAJARIAN whose telephone number is (571) 272-7072. The examiner can normally be reached on Monday - Friday, 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, C. Luke Gilligan can be reached on (571) 272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. N./  
Examiner, Art Unit 3626  
In  
8/6/08

/Robert Morgan/  
Examiner, Art Unit 3626